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Appl. No.: 09/632,808
Amdt. Dated: July 23, 2004
Reply to Office Action of February 23, 2004

PATENT

Remarks/Arguments

Rejection of Claims 1, and 4-8 Under 35 U.S.C. § 103(a)

In the Office Action mailed February 23, 2004, the Examiner rejected claims 1, and 4-8 for reasons of record. For the reasons set forth below, Applicant respectfully disagrees with the Examiner's rejection of claims 1, and 4-8 under 35 U.S.C. § 103(a). The prior art references of U.S. Patent No. 6,202,923 issued to Boyer et al., and U.S. Patent No. 6,493,427, issued to Kobylevsky et al., whether viewed singularly or in combination, do not disclose, teach, or even suggest the inventive concept recited in claims 1, and 4-8. More specifically neither Boyer et al., nor Kobylevsky et al., suggests a method for verifying a renewal of a filled prescription provided by a member health care provider for a patient which can be filled through any one of a variety of member pharmacies with the member healthcare provider being associated with a computer system having a web browser and each member pharmacy having a computer system with a web browser.

On page 6 of the 2/23/04 Office Action, the Examiner rejected the previous arguments contained in Applicant's 11/12/03 response by relying on case law standing for the proposition that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The cases cited are distinguished from the Applicant's previous arguments for several reasons.

First, *In re Keller* involves an applicant attacking an element of a reference after a *prima facie* case for obviousness was established by the examiner. Here, many of the Applicant's

arguments demonstrate that the prima facie case for obviousness has not yet been made.

Second, in each of the cases cited by the Examiner the applicant is only attacking one reference. Here the Applicant has refuted both cited references and maintains because neither reference teaches nor suggests the elements of the inventive concept the combination of the references does not and cannot suggest the inventive concept as set forth in claims 1, and 4-8.

Finally, the most distinguishing factor between the cases cited by the Examiner and Applicant's previous arguments is that in each cited case the applicant is attacking one element of only one reference even though the element is found in another reference relied on by the examiner. Thus, the attack on the element is futile when the references are combined. A simplified example of this type of impermissible argument is as follows:

Reference 1 contains elements *A* and *B* while *Reference 2* contains elements *B* and *C*. The combination of *A*, *B*, and *C* teaches or suggests the applicant's invention. Following the cited cases an impermissible attack would be if the applicant argued that *Reference 2* did not disclose, teach, or even suggest element *B*, because this element is disclosed in *Reference 1*.

In contrast, Applicant's previous arguments were not aimed at one element of only one reference where that element could be found in the other reference. Instead, Applicant's arguments were aimed at specific elements in each reference that the Examiner claimed were present only in the respective reference. Applicant's arguments did not attack an element of a reference that was available in another reference where combining the two references would still suggest that element.

Applicant respectfully renews his previous arguments and summarizes them below.

As background, drug diversion, fraud and errors are very large problems within the pharmaceutical industry. Medical or drug related errors are generally related to a lack of comprehensive patient information and history. These types of errors include excessive or redundant tests, services, prescription errors, missed diagnoses or false starts, as well as illness, hospitalization and death created by conflicting medications or illegible scripts.

Drug fraud and diversion include common schemes such as doctor shopping, pharmacy hopping, stolen, forged or altered scripts, and duplication of scripts, fraudulent "call-in" authorizations and unauthorized use of DEA or state license numbers.

Medical and drug related errors are very costly. In the United States, medical related errors are estimated to cost \$20 - \$177 billion per year. Nationwide, 100,000 people are estimated to die each year and between 1 1/2 - 6 million are harmed each year.

The problems associated with drug fraud and diversion are also very costly. These types of problems have been estimated to have an annual cost of \$25 billion per year.

The present invention of claim 1 is directed to a method which includes the step of providing a members only Internet-based host system database, accessible by a web browser. As a practical matter, Doctors and pharmacies will be verified for legitimacy. Renewal communication is done through the host system in a manner which could be characterized as a two-way internal messaging system. The goal of claim 1 is to facilitate information flow between the pharmacist and the doctor while maintaining a secure environment to help prevent fraud and other types of errors or omissions.

Although Applicant disagrees with the basis for the rejection, the Examiner states as the basis

for the rejection of claims 1, and 4-8 (at pages 2-5 of the 2/23/04 Office Action) that Boyer discloses a method for verifying a renewal of a filled prescription provided by a member healthcare provider for a patient which can be filled through any one of a variety of member pharmacies with the member healthcare provider being associated with a computer system having a web browser and each member pharmacy having a computer system with a web browser. The Examiner also relies on Kobylevsky to provide for the deficiencies found in Boyer. Specifically, the Examiner states that Kobylevsky suggests receiving, by the host system, an authorization from the health care provider system authorizing the requested renewal of the filled prescription; transmitting, by the host system, the authorization to the pharmacy system whereby the pharmacist associated with the pharmacy system is authorized to provide the renewal of the filled prescription to the patient.

It appears to Applicant that Boyer merely teaches an automated pharmacy used to improve the workflow of medication dispensing and to reduce errors during the filling of prescriptions. Boyer's automated pharmacy includes a data entry workstation for processing data relating to a prescription, a filling workstation for dispensing a drug type in a container, a checking workstation where a pharmacist checks and validates that the correct prescription has been dispensed, a counseling workstation for providing information to a customer, and a point-of-sale workstation for providing a prescription to a customer and receiving payment therefore.

Boyer describes an in-house, single location, prescription dispensing system. Essentially, Boyer facilitates automated dispensing of drugs and the only "verification" in Boyer is to verify the correct pill is placed into the correct prescription vial, for a specific prescription. Boyer, however,

does not appear to teach any manner of improving the flow of information between member health care providers and member pharmacies.

Kobylevsky is directed to a system for enhancing the flow of information from patients and/or doctors to a pharmacy. The information flow is one-way, that is, from the patient or doctor to the pharmacy. Kobylevsky does not teach any manner for the pharmacy to communicate with the doctor within their system.

Applicant believes that the Examiner may be correct in determining that it would be obvious to combine the teachings of Boyer with the teachings of Kobylevsky. Boyer teaches an efficient system for filling medicine vials while limiting filling errors by pharmacists and pharmacy staff. Kobylevsky teaches a one-way communication system that allows doctors and patients to pass prescription orders to a single pharmacy or pharmacy chain, through an elaborate voice mail system.

In this regard, Boyer in view of Kobylevsky teaches how to automate a pharmacy to provide drug verification checks within the pharmacy and one manner of facilitating unidirectional information flow from the doctor or the patient to the pharmacy. There is also no method in Boyer or Kobylevsky whether viewed, singularly or in combination, to notify the doctor if any fraud or diversion is occurring with one of the doctor's prescriptions.

In contrast, the inventive concept of claims 1 and 4-8 teaches a method for improving the flow of two-way or bidirectional information between member pharmacies and member health care providers through a host system established as a website. Boyer in view of Kobylevsky does not disclose, teach, or even suggest a method that provides the step of providing electronically a

prescription renewal screen by the host system to a pharmacy system associated with one of the member pharmacies, the prescription renewal screen being associated with a previously filled prescription for bidirectional information flow between member health care providers and member pharmacies. Furthermore, Boyer in view of Kobylevsky, does not disclose, teach, or even suggest a system where pharmacies and doctors have to be members to participate nor does Boyer in view of Kobylevsky teach the step at transmitting renewal information through the host system to a health care provider system. Boyer in view of Kobylevsky also does not disclose, teach, or even suggest a host system established as a website as recited in claim 1, and thus each of the claims that depend therefrom. There is also no method in Boyer or Kobylevsky whether viewed, singularly or in combination, to notify the doctor if any fraud or diversion is occurring with one of the doctor's prescriptions. Neither Boyer nor Kobylevsky addresses this large problem.

As the Examiner is aware the proper test for obviousness is 1) whether the prior art suggests or motivates the modification of the references or the combination of the reference teachings, such that 2) there is a reasonable expectation of success and 3) whether all of the claimed limitations are taught or suggested in the prior art cited by the Examiner. It is the Applicant's belief that even if the prior art suggests or motivates the modification of the references or the combination of the reference teachings such that there is a reasonable expectation of success, all of the claimed limitations are not taught or suggested by Boyer in view of Kobylevsky.

In view of the foregoing, it is Applicant's position that the combination of Boyer and Kobylevsky does not teach or fairly suggest Applicant's inventive concept recited in claim 1, and

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thus, each of the claims that depend therefrom. Reconsideration and withdrawal of the rejection of claim 1 and 4-8 is respectfully requested.

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Summary

The foregoing is intended to be a complete response to the Office Action mailed February 23, 2004. Should the Examiner have any comments or questions regarding the foregoing, Applicant's attorney would welcome a telephonic interview with the Examiner.

Respectfully submitted,

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